UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HUI-JUNG WU and JAMES S. DRAGE

Appeal No. 2005-2522
Application No. 09/841,453

ON BRIEF

Before PAK, KRATZ and MOORE, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This is in response to appellants' request for rehearing of our May 31, 2006 decision, which request was filed on June 28, 2006. In that decision, we affirmed the examiner's decision to reject claims 2-16, 18-21 and 31-34 under 35 U.S.C. § 103(a) as being unpatentable over Jin in view of Grainger and Kotelnikov; to reject claims 22-29 under 35 U.S.C. § 103(a) as being unpatentable over Jin in view of Grainger and Kotelnikov; to reject claim 17 under 35 U.S.C. § 103(a) as being unpatentable over Jin in view of Grainger, Kotelnikov and Burns; and to reject claims 2-29 and 31-34 under the judicially created doctrine of

obviousness-type double patenting over claims 1-19 of U.S. patent No. 6,318,124 in view of Grainger and Kotelnikov.

37 CFR § 41.52 (emphasis supplied) provides, in part, that:

§ 41.52 Rehearing.

> (a)(1) Appellant may file a single request for rehearing within two months of the date of the original decision of the Board. No request for rehearing from a decision on rehearing will be permitted, unless the rehearing decision so modified the original decision as to become, in effect, a new decision, and the Board states that a second request for rehearing would be permitted. **The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. Arguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) and (a)(3) of this section.** When a request for rehearing is made, the Board shall render a decision on the request for rehearing. The decision on the request for rehearing is deemed to incorporate the earlier opinion reflecting its decision for appeal, except for those portions specifically withdrawn on rehearing, and is final for the purpose of judicial review, except when noted otherwise in the decision on rehearing.
> (2) Upon a showing of good cause, appellant may present a new argument based upon a recent relevant decision of either the Board or a Federal Court.
> (3) New arguments responding to a new ground of rejection made pursuant to § 41.50(b) are permitted.

Here, appellants' request for rehearing does not identify and particularly state any points believed to have been misapprehended or overlooked in rendering our prior decision upon which rehearing is sought. Rather, appellants recast arguments

already presented in the briefs without specifically alleging that we overlooked arguments that were made in the briefs or that we misapprehended any points in our Decision mailed May 31, 2006. Compare the arguments made at pages 2-7 of the Request with the arguments presented at pages 6 and 7 of the brief and pages 2-6 of the reply brief. However, we do not find that the request for rehearing particularly points to any of the arguments set forth in the briefs as having been overlooked or misapprehended in reaching our decision of November 30, 2005.

In this regard, we are aware that appellants once again "call upon the Board to follow their decision in the parent case..." (Request, page 5). However, we responded to this argument in our Decision (footnote 5, pages 8 and 9) by stating that "we find that the combined teachings of Jin and Grainger make out a prima facie case of obviousness that has not been persuasively refuted by appellants on this record" and by observing that: "we need not reach the additional teachings of Kotelnikov."[1] In footnote 5 of the prior decision we further

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[1] We note that appellants have not argued, much less persuasively so, that a new ground of rejection was involved in our finding that the combination of the teachings of Jin and Grainger (two of the three references applied by the examiner in the rejection under consideration) furnish sufficient evidence, by themselves, to make out a prima facie case of obviousness of

noted that "appellants refer (reply brief, pages 1-4) to the Board Decision in appeal No. 2003-1366" and we responded by stating that the earlier "Decision was based on a different evidentiary record" and "we decline appellants' invitation to apply that Decision to this appeal." In the Request, appellants have not addressed the above-noted reasoning set forth in our decision, much less stated "with particularity the points believed to have been misapprehended or overlooked by the Board" in rendering our decision as required by 37 CFR § 41.52.

We reiterate that Grainger makes it clear that the hydrophobic, protective films disclosed therein can be applied to a variety of diverse surfaces that include surface oxygen or hydroxide groups, including microporous structures via reaction (chemical adherence or chemisorption) with a surface, such as of a circuit board or other microelectronic device as we noted at pages 6-8, 10, 12, and 14 of our Decision.

Moreover, we note that Grainger is not limited to using long polymeric molecules made by a Langmuir-Blodgett technique as reargued in the Request but rather can employ polymers of a

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the here claimed subject matter.

length corresponding to those disclosed as useful by appellants, as we noted at page 8 of our Decision.

Accordingly, appellants' request does not persuade us that our May 31, 2006 Decision was in error in any respect.

For the above reasons, appellants' request for rehearing is granted to the extent that we have reconsidered our decision, but is denied with respect to making any change thereto.

No period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REQUEST FOR REHEARING - DENIED

CHUNG K. PAK)
Administrative Patent Judge)
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PETER F. KRATZ) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES
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JAMES T. MOORE)
Administrative Patent Judge)

PFK/sld

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